

133 means for transmitting the presentation to a general purpose display station via a configurable network link upon receipt of a command from the display station, wherein the display station comprises a general purpose computer and a browser that operates to display the network presentation.

REMARKS

In the previous Office Action, the Examiner asserted an election/restriction requirement. The Applicants would like to thank the Examiner for withdrawing the election/restriction requirement. In the Office Action, dated July 3, 2002, claims 16-35 were rejected. Applicants respectfully assert that the claims, as amended, are patentable and in condition for allowance.

The Applicants also respectfully request the Examiner to cite specific references on passages to support the elements allegedly *suggested* by the references and, also, to provide support, as required by M.P.E.P. § 2144.03, for the explicit and apparent assertions that certain elements are "well known in the art." Furthermore, the Applicants object to the Examiner's method of rejecting the claims without specifically reciting the basis for the rejections. The Applicants believe that the citations are deficient in view of 37 C.F.R. § 1.104(c)(2), and request that the Examiner provide a more specific citation if the rejections are to be maintained.

Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 16-18, 21-27, 28-31, 34-35 under 35 U.S.C. § 102(e) as being anticipated by Gat (U.S. Pat. No. 5,954,663). Specifically, the Examiner stated:

Gat teaches a network of fetal sensors for sensing multiple patients using a plurality of window pages (see fig 2) that allows a particular patient data to selected by a command that may result in graphical data as seen in figure 2c. The commands allow for realtime display (see column 7 lines 53-59 and column 11 lines 19-25) as well as the

ability to retrieve or playback past data (column 7 lines 28-40). The examiner considers the Gat computer connections to be a configurable network link since the displays are interlinked and configurable to various patients.

The Applicants have amended the claims to clarify the claimed subject matter and believe that the amended claims are not anticipated by Gat. A *prima facie* case of anticipation under 35 U.S.C. § 102 requires a showing that each limitation of a claim is found in a single reference, practice or device. *In re Donohue*, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985). As most of the rejected claims depend from independent claims 16, 23, and 28, and as these claims share certain recitations, the Applicants will address these independent claims together.

Turning first to amended independent claims 16, 23, and 28, the Applicants contend that the amended claims are not anticipated and object to the Examiner's method of rejecting the claims. Broad and overarching citation of the Gat reference, without more, is clearly outside the scope of the requirements of 37 C.F.R. 1.104(c)(2) and provides no useful information concerning the Examiner's position. Accordingly, the Applicants request that the Examiner provide more specific citation and comparison or contrast to the reference if the rejections are to be maintained.

With regard to the missing element in the amended claim, the Gat reference fails to disclose at least one of the limitations, such as "a browser operating to display the network presentation" and "a browser that operates to display the network presentation." As these limitations are found within the amended independent claims 16, 23, and 28, the Gat reference fails to include all of the claimed elements. In fact, no mention of a *browser* is even suggested in the Gat reference. As noted by the Examiner in the Office Action, the Gat reference fails to anticipate a *browser* and as such does not anticipate the claimed subject matter. Thus, the Gat reference fails to anticipate the amended claims, which all include recitation of a browser.

Accordingly, claim 16, 23, 28 and the respective dependent claims are believed to be patentable over the Gat reference. For these reasons, the Applicants respectfully request the Examiner to withdraw the rejections of claims 16-18, 21-27, 28-31, 34-35 under 35 U.S.C. § 102.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 16-35 under 35 U.S.C. § 103(a) as being unpatentable over Gat (U.S. Pat. No. 5,954,663) in view of Brown (U.S. Pat. No. 6,381,577), Halpern et al. (U.S. Pat. No. 5,687,717), or Depsey et al. (U.S. Pat. No. 6,057,758). Specifically, the Examiner stated:

While the examiner considers Gat to teach claims 16-18, 21-27, 28-31, 34-35 in terms of their plain and simple meaning, in the event that the claims are read more narrowly, to be limited to the internet, with a browser, the examiner considers the use of such to be obvious in view of the wealth of prior art. Brown teaches the advantages of providing patient monitoring system to enable multiuser capabilities and to provide feedback to healthcare industry. Halpern et al, likewise uses an internet environment (column 8 line 42) for fetal monitoring (column 11 54) and Dempsey et al as well. In lieu of that shown in the prior, the examiner considers it obvious to employ the Gat fetal monitoring system on an internet type connection since it was well known in the art to do so for the benefits expressed by Brown Halpern and Dempsey.

The Applicants respectfully traverse this rejection as the claimed combination fails to make the claimed subject matter obvious. The Applicants have cancelled claims 20 and 33 without prejudice and incorporated the features recited in them into their respective independent claims as a means of clarifying the presently claimed subject matter.

No new matter has been added in this response, and the claims are believed to be in condition for allowance. Accordingly, the Applicants respectfully request

reconsideration of the present application in light of the following remarks. As the many of the claims depend from independent claims 16, 23, and 28 and the rejections are unfounded for similar reasons, the Applicants will address these independent claims together.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Furthermore, the Applicants also respectfully request the Examiner to cite specific references and passages to support the alleged suggestion or motivation to combine the cited references. Also, the Applicants request that the Examiner provide support, as required by M.P.E.P. § 2143, for the explicit and apparent assertions that the references teach or suggest to make the claimed combination. The Applicants respectfully stress

that *each claim* is patentably distinct and must be addressed individually to properly account for the unique aspects recited therein.

Turning to the amended independent claims, the Examiner rejected claims 16, 23 and 28 in view of different combinations of references. The specific combination and elements found in the different references is unclear to the Applicants, as the Examiner has rejected all of the claims under a general broad assertion, which provides no guidance to the Applicants. As understood, however, the Examiner's rejections are unsupportable for at least three reasons. First, the Examiner's method of rejecting the claims is clearly inconsistent with the requirements of 37 C.F.R. 1.104(c)(2). Second, the Examiner has provided no motivation to suggest the combination of these references, which in fact do not teach the asserted combination. Third, the references cited by the Examiner teach away from or simply do not teach or suggest the invention even if joined in the suggested combination.

First, with regard to the Examiner's method of rejecting the claims, the Applicants contend that the Examiner's method of rejecting the claims is inconsistent with the requirements of 37 C.F.R. 1.104(c)(2). Specifically, the Examiner rejected all of the claims under the same broad statement, which provides no guidance to the Applicants. Clearly, the Examiner has failed to cite the particular parts relied upon for the rejections as required by 37 C.F.R. 1.104(c)(2). Accordingly, the Applicants request that the Examiner provide more specific citation if the rejections are to be maintained.

Furthermore, with regard to the second reason that the Examiner's rejections fail, the Examiner has provided no motivation or suggestion for the combination of these references. The Examiner has the duty to provide support for the alleged suggestion or teaching to combine the references. Accordingly, the Applicants respectfully request the Examiner to cite specific references and passages to support the alleged suggestion or motivation to combine these references. Also, the Applicants request that the Examiner

provide support, as required by M.P.E.P. § 2143, for the explicit and apparent assertions that the references teach or suggest to make the claimed combination. The Applicants respectfully stress that *each claim* is patentably distinct and must be addressed individually to properly account for the unique aspects recited therein.

Moreover, the Examiner must still present a *convincing* line of reasoning as to why one of ordinary skill in the art would have found the combination obvious. Applicants respectfully reiterate that the burden of establishing a *prima facie* case of obviousness falls upon the Examiner. Accordingly, the Examiner must provide relatively specific reasons as to why to the skilled artisan would have been motivated to make the proposed combination of the cited references. Merely stating that three references taken in combination recite all the elements of the instant claim followed by a conclusory statement that the combination of references would have been obvious fails to satisfy this burden.

Additionally, a review of the cited references shows that they simply do not teach the claimed invention, even if joined in the proposed combination, which is the third reason the Examiner's rejection fails. For example, Gat merely suggests an automated monitoring system that allows a single processor to handle multiple fetal monitoring sensors in a closed system. Col. 12, lines 36-67, and Figs. 7 and 8. The singular purpose of the reference is to permit a single computer to control a group of fetal sensors. Thus, the singular purpose of the Gat reference clearly goes against teaching of a *general purpose display*, *general purpose network presentation*, or a *general purpose computer*. Furthermore, Brown merely suggests a method of allowing remote patients to input personal information into a server that is accessible over the Internet. Col. 3, lines 16-30. There is no suggestion within the Brown reference that a patient, let alone a fetus, be actively monitored for changes in the patient's condition. In fact, the Brown reference is designed for patients, which are

able to communicate and input data into the system. This manual approach to input is in clear contrast with fetal monitoring or any type of automated monitoring.

Turning to the Halpern et al. reference, this reference teaches away from using a browser and does not even disclose a browser within the reference. Indeed, the Halpern et al. reference discloses using GUI 42 to modify and view the images. Col. 9, lines 8-26. In contrast to the Examiner's assertion, the reference teaches the use of different software to display information, not the use of a web browser. Similarly, the Dempsey et al. reference teaches away from the presently claimed subject matter as well. The Dempsey et al. reference is directed to handheld devices that are designed to overcome the problems with permanently attached devices. Col. 2, line 34 to Col. 3, line 21. Accordingly, the Dempsey et al. reference teaches a wireless connection to overcome the problems associated with permanent locations. While the Dempsey et al. reference does disclose a browser, the browser is not used to display the network presentation, but is merely used to download code for the handheld unit. Col. 10, lines 36-54. In fact, only a single reference is made to a browser is in relation to the downloading of code into the handheld device. Further, the reference clearly teaches away from a combination with a fixed system because the wireless system is directed to solving the problems with the fixed system.

The teachings of the cited references clearly include no motivation for the Examiner's combination. Because the Examiner has failed to show a convincing line of reasoning as to why one of ordinary skill in the art would have found the combination obvious, the Examiner has failed to present a valid § 103 rejection. Accordingly, independent claims 16, 23, 28, and the respective dependent claims are believed to be patentable over the combined references. For these reasons, the Applicants respectfully request the Examiner to withdraw the rejections of claims 16-19, 21-32, and 34-35 under 35 U.S.C. § 103.

Double Patenting

The Examiner rejected claims 16-35 under the judicially created doctrine of obviousness-type double patenting over U.S. Patent No. 6,350,237, which is a related application. Specifically the Examiner stated:

Claims 16-35 are rejected under the judicially created doctrine of double patenting over claims 1-7 of U.S. Patent No. 6,350,237 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: As noted in applicant's response, the new claims 17-35 correspond to those of the patent claims which are patently indistinct from claims 16-27 in this application.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant applicant during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

At the outset, it should be stated that the Examiner's rejection is clearly in error to the extent that the Examiner is relying upon subject matter that is *disclosed* in the issued patent. The doctrine of obviousness-type double patenting was judicially created to prevent a patentee from essentially extending patent rights past the statutory term of a first patent by obtaining a second, later patent with claims that, while not identical to the claims in the earlier patent, were merely obvious variations of claims in the first patent. In the present case, the issued patent is related to the present application and, thus, contains the same specification. Accordingly, it is not surprising that the presently claimed subject matter is fully disclosed in the issued patent.

In Office Action dated February 8, 2001 of the issued patent, the Examiner stated that:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, drawn to a fetal monitor using separate controllers at either end of a network, classified in class 600, subclass 300.
- II. Claims 8-15, drawn to a fetal monitor with local processing and remote display, classified in class 600, subclass 300.
- III. Claims 16-22, drawn to a fetal monitoring method of remote display of raw data, classified in class 600, subclass 300.
- IV. Claims 23-27, drawn to a fetal monitoring method of remote display of an updated interface page, classified in class 600, subclass 300.

In response to this restriction requirement, the Applicants elected to prosecute claims 1-7, which issued in the cited patent. Contrary to the Examiner's assertion that "there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant applicant during prosecution of the application which matured into a patent," the Applicants were required to elect one distinct invention within the initial application. As noted in the Office Action dated February 8, 2001, the claims were restricted because these inventions are distinct. In fact, M.P.E.P §806 clearly states that, where the Office requires a restriction, double patenting cannot be held. Thus, the Examiner's double patenting rejection is not valid and is unsupportable against the present claims 16-35 in view of issued patent. For these reasons, the Applicants respectfully request the Examiner to withdraw the double patenting rejection of claims 16-19, 21-32, and 34-35.

Conclusion

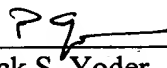
In view of the above remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a

telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Attached hereto is a marked-up version of the changes made to the drawings and claims by the current amendment. The attached page is captioned **"Version with markings to show changes made."**

Date: 8/30/2002

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

Claim 16, 23 and 28 have been amended as follows:

16. (Twice Amended) A method for monitoring a fetal condition, the method comprising the steps of:

(a) detecting a fetal parameter of interest and generating a fetal condition signal representative thereof;

(b) storing the fetal condition signal;

(c) defining a general purpose network presentation including data representative of the fetal condition signal; and

(d) transmitting the presentation to a general purpose display station via a configurable network link upon receipt of a command from the display station, wherein the display station includes a general purpose computer and a browser operating to display the network presentation.

23. A method for remotely monitoring a fetal condition via a configurable network connection, the method including the steps of:

(a) monitoring a physiological parameter of a fetus and generating fetal parameter data representative thereof;

(b) defining a user viewable interface page including user selectable command devices;

(c) updating the interface page to include the parameter data;

(d) establishing a network link between a server and a client station; and

(e) transmitting the updated interface page from the server to the client station for display via a general purpose computer and a browser that operates to display the network presentation.

28. (Amended) A system for monitoring a fetal condition, the system comprising:

means for detecting a fetal parameter of interest and for generating a fetal condition signal representative thereof;

means for storing the fetal condition signal;

means for defining a general purpose network presentation including data representative of the fetal condition signal; and

means for transmitting the presentation to a general purpose display station via a configurable network link upon receipt of a command from the display station, wherein the display station comprises a general purpose computer and a browser that operates to display the network presentation.